

PATENT

Atty Docket No.: 10010944-2
App. Ser. No.: 10/696,837REMARKS

In response to the Notice of Non-Compliant Amendment, dated December 19, 2008, Applicant has corrected the present listing of claims to show that Claims 1 through 7 have been Canceled. Note that the Divisional Application filed by Applicant on October 30, 2003, also indicates that Claims 1 through 7 had been canceled, so the present response does not introduce any new matter or material. For ease of reference, Applicant has also included the previously filed Remarks, dated December 5, 2008.

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

Claims 8-14 are pending in the present application, of which Claim 8 is independent. No amendments to the claims have been made.

Allowance of Claims 9-14

Applicant Appreciates that the examination of Claims 8-14 has found them allowable over the prior art, and Thanks the Examiner for the time spent reviewing them.

Rejection of Claim 8 Under 35 U.S.C. §102(b)

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221

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USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claim 8 has been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by the disclosure contained in U.S. Patent No. 6,111,685 to Tench et al. This rejection is respectfully traversed for at least the following reasons.

Independent Claim 8 pertains to, *inter alia*, a molecular system configured between a pair of electrodes. Claim 8 recites that said molecular system includes at least one organic non-polymeric molecule that *changes color* [italics added] when oxidized or reduced by an electric current.

The Official Action asserts that Tench et al. teaches an “organic non-polymeric molecule (col. 9, ln. 8) that changes color when oxidized or reduced by an electric current (abstract)”. In other words, the Official Action appears to assert that the Abstract’s discussion of “ions of a metal which can electrodeposit on the electrodes” thereby creating a

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mirror on either of the electrodes with affects reflectivity is equivalent to the claimed “organic non-polymeric molecule that *changes color* [italics added]”.

Applicants assert that the claimed “changes color”, as discussed in paragraph [0041] of the specification and effected by “electrons are removed from the easily oxidized material and transferred through external circuitry to the material that can be reduced [such that] one of these materials undergoes a color change, the result is a switch in the color state of the device” is not equivalent to Tench’s electrodeposit of metal on an electrode. In other words, the Claimed “oxidized or reduced” is not equivalent to Tench’s stated “electrodeposit”. In addition, Tench et al. fails to disclose any sort of molecular “color changes” but instead pertains to metal deposition on electrodes.

For at least the foregoing reasons, Tench et al. fails to disclose each and every element claimed in independent Claim 8 of the present invention and therefore cannot anticipate these claims. The Examiner is therefore respectfully requested to withdraw this rejection and to allow Claim 8 and the claims that depend therefrom.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below.

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Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

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